

**REMARKS**

Claims 1, 4-13, 15-34, and 39-42 are pending in this application. Claims 2-3, 14, and 35-38 have been cancelled. Claims 39, 40 and 42 have been amended. It is believed that no new matter has been added by this amendment.

Claims 1, 4-13, and 15-42 are rejected as follows: Claims 1-3, 4-13, and 15-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,864,641 to Murphy et al. (“Murphy”) in view of U.S. Patent Application Publication No. 2003/0146109 to Sailor et al. (“Sailor”) and further in view of U.S. Patent Number 5,377,008 to Ridgway et al (“Ridgway”). In view of the amendments and remarks presented herein, the undersigned respectfully traverses these rejections as set forth below.

**Rejection Claims under 35 USC 112**

Claims 39, 40 and 42 have been amended and this rejection is believed to have been overcome.

**Rejection Claims under 35 USC 103(a)**

It is respectfully submitted that Murphy, Sailor, and Ridgway, individually or in view of each other, fail to describe, teach, or suggest the combination of limitations set forth in independent claims 1, 10 and 20. Accordingly, the undersigned submits that the Office Action fails to establish a *prima facie* case of obviousness for Claim 1. More particularly, as admitted by the Office, none of the cited references teach or suggest the third filter/optical grating comprising a porous Bragg grating; and comparing the measured optical property of the third filter/optical grating to the measured optical property of the first and second filters/optical gratings to determine a presence of spurious signals caused by the environment. Instead, the Office relies on case law directed to duplication of parts to support a *prima facie* case. Importantly, section 2144 of the MPEP is quite clear in pointing out that legal precedent can provide the rationale supporting obviousness only if the facts in the cited case are sufficiently similar to those in the application. More particularly,

The examiner must apply the law consistently to each application after considering all the relevant facts. If the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court.

In this case, the Office argues:

It would have been obvious to one of ordinary skill in the art to measure a third optical grating that has not been exposed to the sample, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. St. Regis Paper Col. V, Bemis Co., 193 USPQ 8. It would have been obvious to have a grating that does not contact the sample and to compare it with measurements from the first and second filters since it is well known in the art to use a reference for measurements for increased accuracy due to the cancellation of effects that are common to the environment and measurement system. This is evidenced by Col. 4, L 15-35 of Ohtsuka et al. US Patent # 6,791,691, Col. 2, L 6-67 of Rosenberger et al. US Patent # 6,781,696 and Col.14, L 3-5 of Arnold et al. US Patent #6,713,516.

Initially, the patent references cited as evidence are directed to (1) use of a reference chip to measure attenuation angle to determine if a false sample liquid is present (Ohtuska); (2) using microspheres having light with certain characteristics introduced therein, wherein when the microspheres are contacted with a sample, the behavior of the light provides information about the sample (Rosenberger); and (3) Sulphonamide derivatives (Arnold). The latter has nothing to do with the claimed technology and the undersigned assumes there has been a typo. Additionally, the undersigned fails to see how the cited portions of reference (2) evidence the Office's statement as there is no discussion of multiple microspheres, wheren one is a reference. Finally, reference (1) does describe using a reference chip, but not in the manner or for the claimed purpose. And none of the references teach/suggest/evidence a 3 filter system as claimed.

Further, the undersigned has reviewed the case referenced by the Office, St. Regis Paper Col. V. Bemis Co., 193 USPQ 8, and simply does not see where it holds that the "mere duplication of the essential working parts of a device involves only routine skill in the art" as stated by the Office. The undersigned also notes that the facts of the St. Regis case are in no way similar to the facts before the office in this application. As such, this cases, whatever the

Serial No. 10/614,188

holding, is not applicable. The Office has failed to present a *prima facie* case of unpatentability for the pending claims.

### **CONCLUSION**

The undersigned believes that claims in this application are allowable over the cited prior art and respectfully requests a notice of allowance to this effect. Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below. In addition, if any additional fees are required in connection with the filing of this response, the Commissioner is hereby authorized to charge the same to Deposit Account No. 504402.

Respectfully submitted,

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